

PATENT
Customer No. 22,852
Attorney Docket No. 05725.0490-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re National Stage of International)
Application No. PCT/FR99/00609 of:)
Nadia TERREN et al.) Group Art Unit: 1617
Application No.: 09/423,974) Examiner: L. Wells
International Filing Date: November 17, 1999)
35 U.S.C. §371 date: January 5, 2000)
For: USE OF A SILICONE SURFACTANT)
OF ALKYL-DIMETHICONE)
COPOLYOL TYPE FOR PREPARING)
SOLID WATER-IN-OIL COSMETIC)
EMULSIONS AND RESULTING)
SOLID WATER-IN-OIL EMULSIONS)

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Sir:

REPLY BRIEF UNDER 37 C.F.R. § 1.193

Pursuant to 37 C.F.R. § 1.193, Appellants submit this Reply Brief to the Board of Patent Appeals and Interferences in response to the Examiner's Answer dated May 14, 2003.

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I. Status Of Amendments After Final

The Office asserts that Appellants' statement of the status of amendments after final rejection is incorrect because the Amendment after Final rejection filed on August 7, 2002, was not entered. *Answer* at p. 2, section (4).

Appellants respectfully submit that the Advisory Action dated September 10, 2002, indicated that "[f]or purposes of Appeal, the proposed amendment(s) . . . will be entered." *See Advisory Action*, checked item 7b). Thus, Appellants understood from the Advisory Action that the Amendment after Final was entered once their Notice of Appeal was filed.

Moreover, other sections of the Answer suggest that the Office considered the Amendment after Final as being entered. First, the Office agrees with Appellants that their statement of the status of the claims contained in the Appeal Brief is correct. *Answer* at p. 2, section (3). In their statement of the status of the claims, Appellants had noted that claim 94 was cancelled in the Amendment filed on August 7, 2002. *Appeal Brief* at p. 2, section III. The Office also notes in the Answer that the copy of the appealed claims contained in the Appendix to the brief is correct. *Answer* at p. 2, section (8). The Appendix includes claim 87 as amended after final and does not include cancelled claim 94. *Appeal Brief* at p. 21. Finally, the Office agreed with the Appellants' statement of the issues. *Answer* at p. 2, section (6). In the Appeal Brief, Appellants did not list the rejection of claims 87-89 and 94 under 35 U.S.C. § 112, second paragraph because the rejections were addressed in the Amendment after Final. *Appeal Brief* at pp. 4-5, section (VI).

Accordingly, for the purposes of this Appeal, Appellants respectfully request that the Office consider the Amendment after Final as entered.

II. Response to Examiner's Answer

A. Rejection under 35 U.S.C. § 112

Appellants respectfully maintain their position of record that the term "transfer-resistant" is sufficiently definite under § 112, second paragraph. As argued in the Response after Final Office Action and in the Appeal Brief, "transfer-resistant" is a term well known in the art. Because of its common usage, one of ordinary skill in the art would be readily apprised of the meaning of "transfer-resistant."

B. Rejections Under 35 U.S.C. § 103(a)

Claims 75-80, 82-93 and 96-107 stand rejected under 35 U.S.C. §103(a) as unpatentable in various combinations over Mellul et al. in view of Nicoll et al., Nojima, or Nara et al.. See, e.g., Appeal Brief at p. 5. Appellants maintain their positions of record regarding these rejections, and add the additional arguments set forth below in response to certain statements made in the Examiner's Answer. Appellants note that they disagree with all of the positions taken by the Office in the Answer, but as their viewpoints were made clear in the Appeal Brief on many of these issues, they have chosen to address only selected portions of the Answer below.

1. “Capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams” should be granted patentable weight

The Office asserts that “capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams” is not a positive limitation and “does not constitute a limitation in any patentable sense,” citing *In re Hutchinson* as support. *Answer* at p. 8.

As an initial matter, Appellants respectfully disagree that *In re Hutchinson* promotes such a broad holding. There, the C.C.P.A. held that “laminated article ... ‘adapted’ for use in making a template ... does not constitute a limitation in any patentable category.” *In re Hutchinson*, 154 F.2d 135, 138 (C.C.P.A. 1946). The court, however, did not propose that “adapted for” was not a patentable limitation *per se*; these statements were limited to the facts of *Hutchinson*. The M.P.E.P. is consistent with the *Hutchinson* holding in stating that “Office policy is not to employ *per se* rules to make technical rejections.” M.P.E.P. § 2173.02.

Further, it appears that the Office refuses to grant patentable weight to “capable of conferring a penetration force” at least in part because this limitation comprises functional language. Appellants submit that, for several reasons, this is an improper position for the Office to take. First, functional limitations “must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.” M.P.E.P. § 2173.05(g). Here, the phrase “capable of conferring a penetration force” fairly conveys to the person of ordinary skill that the wax at issue must have a certain level of solidity to have such a capability. This is a patentable limitation in the present claims, because, as discussed of record, not all waxes have this capability. Second, “[a]ll

words in a claim must be considered in judging the patentability of a claim against the prior art." M.P.E.P. § 2173.06; *In re Wilson*, 424 F.2d 1382 (C.C.P.A. 1970). Here, the Office is clearly not considering all of these words, and in fact seems to be ignoring this limitation in its analysis. Third, in response to the Office's assertion that "capable of" is not a positive limitation, Appellants note that the M.P.E.P. states that negative limitations can comprise suitable claim language "so long as the boundaries of the patent protection sought are set forth definitely, albeit negatively." M.P.E.P. § 2173.05(i).

Finally, Appellants also note that the Office previously treated this limitation as a patentable limitation. In the Final Office Action dated May 7, 2002, the Office withdrew the rejection under 35 U.S.C. § 102(b) over EP 595 683 because the "reference does not teach the capability of the wax to confer a penetration force greater than 50 grams on the emulsion as instantly claimed." *Final Office Action* at p. 3. By acknowledging this limitation as the reason for withdrawing a § 102 rejection, the Office acknowledges the patentability of this limitation.

For at least these reasons, Appellants respectfully submit that "capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams" should be granted patentable weight.

2. Mellul, when read as a whole, provides no specific guidance to the claimed combination of ingredients

In response to the Office's statements about the teachings of Mellul (see, e.g., Answer at pp. 8-12), Appellants respectfully maintain that the Office's basis for this rejection amounts to picking and choosing isolated passages from Mellul to arrive at the

Appellants' specifically claimed combination of limitations, without any guidance to do so. Such piecemeal consideration of the references is, of course, improper.

Appellants previously argued that Mellul does not provide specific guidance to one of ordinary skill in the art to select the specifically recited silicone oil and/or at least one wax. *Appeal Brief* at pp. 11-12. The Office asserts that these arguments are unpersuasive because they are not "commensurate in scope with the instant independent claims, which do not require specific oils or waxes." *Answer* at pp. 9-10. Appellants respectfully disagree because the claims do recite specific oils and waxes. Specifically, independent claims 75, 104, and 107 recite a silicone oil having a specified formula, and claims 75 and 104 further require at least one wax chosen from only polyethylene wax, hydrogenated jojoba oil, and ozokerite, among other limitations. Thus, Appellants submit that their arguments are commensurate in scope with the independent claims.

Further, Appellants agree with the Office that a reference's teachings should not be limited to its preferred embodiments. See *Answer* at p. 9 and p. 11. Appellants respectfully submit, however, that Mellul, even when read as a whole, does not teach the claimed combination. Mellul discloses a composition comprising general classes of ingredients. Mellul further gives long lists of examples for each class of ingredients. Thus, when read as a whole, Mellul provides a near infinite number of compositions besides the preferred embodiments disclosed therein. Mellul does not suggest the desirability of the claimed invention, as required by M.P.E.P. § 2143.01 ("The prior art must suggest the desirability of the claimed invention."). Thus, Mellul does not guide

one of ordinary skill in the art to select the specifically claimed combination of ingredients.

The Office relies on *In re McLaughlin* to justify that “any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning ... so long as it takes into account only the knowledge which was within the level of ordinary skill ...” *Answer* at p. 10, citing *In re McLaughlin*, 443 F.2d, 1392 (CCPA 1971).

Appellants respectfully submit that *In re McLaughlin* does not circumvent the well-settled requirement of showing a suggestion or motivation to combine references. No case can “outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence.” *See In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002) (added emphasis). Thus, Appellants continue to respectfully maintain that Mellul does not provide the requisite evidence necessary to establish a *prima facie* case of obviousness.

Accordingly, Appellants respectfully submit that their arguments do not rest on Mellul’s preferred embodiments but on the teachings of Mellul as a whole.

3. The combined teachings of Mellul and Nicoll, as a whole, teach directly away from the claimed invention

In response to Appellants’ assertions that Nicoll directly teaches away from a solid composition, the Office states that Nicoll “is merely relied upon to teach the interchangeability of silicone oils in cosmetic compositions.” *Answer* at p. 12.

Appellants respectfully submit that Nicoll must be read as a whole. Mellul does not teach one of ordinary skill in the art to specifically select a solid composition, as Mellul states that its emulsions can have different viscosities “ranging from the very fluid

to the solid state." *Mellul* at col. 10, lines 16-21. Nicoll, in contrast, specifies an emulsion formulated as a lotion, a fluid, or a cream. *Nicoll* at col. 10, lines 32-45. Nicoll thus directly teaches away from solid compositions, *i.e.*, all teachings of Nicoll, whether they be interchangeability of silicone oils or other teachings, are directed towards non-solid formulations, in direct contrast to Appellants' claimed invention.

Accordingly, for at least these reasons, Appellants respectfully maintain that a *prima facie* case of obviousness based on *Mellul* and *Nicoll* has not been established.

4. There is no motivation to combine *Mellul* with *Nojima*

In response to Appellants' assertion that *Nojima* fails to describe a water-in-oil emulsion, the Office states that "*Nojima* was merely relied upon to teach that it is known to combine polyethylene wax and hydrogenated jojoba oil in the oil phase of cosmetic compositions." *Answer* at p. 13.

Applicants respectfully submit that when a rejection relies on a combination of references, there must be a motivation to combine reference teachings. M.P.E.P. § 2143.01, citing *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). ("Absent any proper motivation to combine part of Levine's teachings with Freeburg's satellite system, the rejection of Rouffet's claim over these references was improper and is reversed."). Under this principle, regardless of the teachings of *Nojima* relied on by the Office, the Office must first show a motivation to combine *Mellul* and *Nojima*. Appellants respectfully maintain that *Mellul* teaches a water-in-oil emulsion, and *Nojima* fails to teach the use of an emulsion, *i.e.*, *Mellul* and *Nojima* describe very different types of

formulations. Thus, there is no motivation to apply the ingredients of Nojima's non-emulsion formulation to Mellul's emulsion.

Accordingly, for at least these reasons, Appellants respectfully maintain that a *prima facie* case of obviousness based on Mellul and Nojima has not been established.

5. There is no motivation to combine Mellul with Nara

In response to Appellants' assertion that there is no teaching in Mellul that the ethyl hydroxyethyl cellulose compositions of Nara would benefit Mellul's compositions, the Office asserts that "Nara is merely relied upon to teach that isoparaffins are cosmetically acceptable oils that can be combined with silicones and waxes." *Answer* at p. 13.

For the same reasons stated in the previous section, Appellants respectfully submit that the Office has failed to provide a motivation to combine the teachings of Mellul with those of Nara. Without such motivation, none of the teachings of Nara can be relied upon to support a *prima facie* case of obviousness based on the combination of Mellul and Nara.

Accordingly, for at least these reasons, Appellants respectfully maintain that a *prima facie* case of obviousness based on Mellul and Nara has not been established.

III. Conclusion

For the reasons set forth above, Appellants maintain that a *prima facie* case of obviousness has not been established by the Office based on the cited references, taken alone or in combination. Appellants maintain their position on all issues covered by the Appeal Brief filed on February 28, 2003. Thus, Appellants respectfully request

reversal of all the rejections of claims 75-80, 82-93, and 96-107 under 35 U.S.C. § 103(a), as well as the rejection of claim 107 under 35 U.S.C. § 112, second paragraph.

To the extent any further extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Date: July 7, 2003

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